

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Jukka SALLINEN et al.)	Group Art Unit: 1617
)	
Application No.: 10/510,020)	Examiner: Kathrien Ann CRUZ
)	
Filed: April 28, 2005)	
)	Confirmation No.: 4497
For: USE OF AN ALFA2-)	
ADRENORECEPTOR)	
ANTAGONIST FOR CNS-)	
RELATED DISEASES)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated October 31, 2008, the Examiner indicated that the "claims [are] directed to more than one species of the generic invention." Restriction Requirement at 2. Moreover, the Examiner concluded that "[t]hese species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1" *Id.* As a consequence, the Examiner required election of a single ultimate species from group A (claims 2-8, various symptoms) and a species from group B (claims 9-12, disorders or conditions). *Id.*

Applicants provisionally elect with traverse psychotic cognitive impairment from group A. At least claims 1, 2, 7, and 13-15 read on that species. Applicants also

provisionally elect with traverse schizophrenia from group B. At least claims 1, 9, 10, and 13-15 read on that species.

Applicants traverse the required elections because the Examiner appears to impermissibly adopt U.S. Patent and Trademark Office restriction practice under 35 U.S.C. § 121 even though PCT Rule 13.1 is cited as the requisite authority. Applicants respectfully point out that the Examiner in a national stage application must follow the precepts of PCT Rules 13.1 and 13.2. See M.P.E.P. § 1850 (“Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and **during the national stage as a Designated or Elected Office under 35 U.S.C. 371**, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111.”) (emphasis added). Applicants respectfully assert that the present claims possess unity of invention under PCT Rules 13.1 and 13.2 as recognized in the International Preliminary Examination Report, i.e., Box IV was not checked.

Indeed, the present claims all contain a uniting technical feature, namely that the claimed disorders/conditions are all related to sensorimotor gating deficits and alpha2C-adrenoceptor antagonists. That technical feature is pointed out in the present specification at, for example, page 1, lines 20-25 and page 5, lines 12-27. If a uniting technical feature is present, as is the case here, an *a priori* assessment of unity of invention is warranted and “the benefit of any doubt [should be] given to the applicant.” M.P.E.P. § 1850.

Moreover, where as here, Markush practice is being used, "when the alternatives are of a similar nature," unity of invention should be found. See *id.* In other words, if there is a reasonable similarity among the Markush group, a species election is not appropriate. Here the elements of the Markush group are of a similar nature: either they are symptoms associated with diseases/conditions linked to sensorimotor gating deficits, or they are disorders/conditions associated with sensorimotor gating deficits. The symptoms are not as the Examiner stated "different and unrelated." In addition, the presently claimed disorders and conditions, which may have different etiologies and treatments as acknowledged by the Examiner, are of a similar nature. In particular, "[s]ensorimotor gating [] deficits are observed in subgroups of patients with certain neuropsychiatric disorders, such as [those presently claimed.]" Specification at page 1, lines 20-21. Therefore, for this additional reason, the species elections are improper and should be withdrawn.

CONCLUSION

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 28, 2009

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